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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,850	05/10/2001	Andrew J. Vilcauskas JR.	KDO:195860-3	6730

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,850

Applicant(s)

VILCAUSKAS ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication received on May 10, 2001.

Claims 1-18 are currently pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on May 10, 2001 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has the language that a cease and desist module is capable of attempting to remove the infringing content. In the method claims, the applicant has the step of "attempting to remove". It is unclear what the applicant means by "attempting to remove" and what is making the "attempt."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 15-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 15-17 only recite an abstract idea. The recited steps of merely scanning a communication medium for potentially infringing content, passing a reference address of a potential infringer to an infringement-identification module, determining whether infringing content is present, passing a reference address and attempting to remove the infringing content do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how detect and prevent intellectual property infringement.

Mere intended or trivial use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

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In the present case, the scanning of the communication medium for potentially infringing content can be performed by someone sitting at a computer and scanning it for potentially infringing content. Passing the reference address of a potential infringer to an infringement –identification module is just storing data. The determining step as to whether infringing content is present does not involve the computer. Thus, there is only trivial use of technology in the body of the claim language.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney (US 6,289,341) (hereinafter referred to as Barney) in view of Thomas (US 6,401,118) (hereinafter referred to as Thomas).

Referring to claim 1:

Barney discloses a system for detecting and preventing infringement of intellectual property over a communication medium, said system comprising:

- (a) a database of intellectual property (Figure 1 (140) IP Database);
- (b) at least one service module for interfacing with a communication medium (Figure 1 (160, 170, 180));
- (c) a data processing system interfacing with at least one service module and database, said data processing system accessing the database to search and retrieve intellectual property over a communication medium and detecting possible infringements of the intellectual property and producing a list of possible infractors (Figure 1 (110)) intelligent agent (col. 3, line 62 thru col. 4, line 31);
- (d) an infraction module interfacing with the data processing system for receiving the list of possible infractors from the data processing system and verifying infringements and producing an actual list of infractors (Figure 1 (120) Site Database, (130) Site Examiner, (150) Favorable Comparison Database (col. 1, line 59 thru col. 2, line 16)).

Barney does not disclose a cease and desist module interfacing with the infraction processing system for receiving the list of actual infractors from the infraction module and attempting to stop the infringements.

However, Thomas disclose a cease and desist module interfactable with the infraction processing system for receiving the list of actual infractors from the infraction module and attempting to stop the infringements (col. 11, lines 44-67; figure 3 (322)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 2:

Barney discloses the at least one service module selected from a group of service modules including Internet Relay Chat (IRC), Usenet news group, WWW, Wide area Information Systems (WAIS), Gopher, FTP (col. 2, lines 17-29; Figure 1 (160, 170, 180))

Referring to claim 3:

Barney discloses wherein the service module is a plurality of service modules interfactable with one another (Figure 1).

Referring to claim 4:

Barney discloses the data processing system further comprises at least one module consisting of at least one database interface module (Figure 1 (110)).

Referring to claim 5:

Barney discloses the data processing system (Figure 1 (110)) further comprising at least one infringement identification module (Figure 1 (120) Site Database) interfacing with at least one service module (Figure 1 (160) (170) (180)) and the infraction module for receiving content input from the service module, comparing the

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content input to intellectual property, and outputting matches between the content input and the intellectual property (Figure 2; col. 4, lines 8-31).

Referring to claim 6:

Barney discloses said content listing further comprising at least one of Usenet traffic listing, FTP content listing, IRC offering listing, and WWW site listing (col. 2, lines 17-29; col. 3, line 63 thru col. 4, line 29; Claims 2, 8 and 14).

Referring to claim 7:

Barney discloses a reporting module interfacing with the infraction module for summarizing infringements identified by the infraction module (Figure 1 (150) Figure 2 (260); col. 1, line 59 thru col. 2, line 4; col. 4, lines 23-31; col. 5, lines 49-56)

Referring to claim 8:

Thomas discloses a reporting module interfacing with the cease and desist module (col. 11, lines 44-67)

Referring to claim 9:

Barney discloses a system for detecting and preventing intellectual property infringement over a communication medium, said system comprising:

(a) at least one service module for scanning communication medium services for potentially infringing content and capable of passing a reference address from a communication medium service having potentially infringing content (Figure 1 (110); col. 1, line 59 thru col. 2, line 29; col. 4, lines 8-29);

(b) an infringement identification module for receiving the reference address and determining whether potentially infringing content is present (Figure 1 (120 and 130), Figure 2; col. 1, line 62 thru col. 4, line 29; col. 4, line 48 thru col. 5, line 56);

(c) an infraction module for receiving the reference address and identifying infringing content (Figure 1 (130) col. 5, lines 1-56).

Barney does not disclose a cease and desist module for receiving the reference address and attempting to remove the infringing content.

However, Thomas discloses a cease and desist module for receiving the reference address and attempting to remove the infringing content.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 10:

Barney discloses a reporting module for reporting attempts by the cease and desist module to remove infringing content (col. 11, lines 44-67).

Referring to claim 11:

Barney discloses a plurality of service module interfacing with one another to provide a communication link to a possible infractor (Figure 1).

Referring to claim 12

Barney discloses a system for detecting and preventing intellectual property infringement over a communication medium, the system comprising:

(a) at least one service module for scanning a communication medium for potentially infringing content and passing a reference address of a potential infringer (Figure 1 (160, 170, 180); col. 3, line 62 thru col. 4, line 31);

(b) an infringement identification module for receiving the reference address of a potential infringer and determining whether infringing content is present and passing a reference address of an infringer (Figure 1 (110) col. 4, lines 8-31).

Barney does not disclose a cease and desist module for receiving the reference address of an infringer and attempting to remove the infringing content.

However, Thomas discloses a cease and desist module for receiving the reference address of an infringer and attempting to remove the infringing content (col. 11, lines 52-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 13:

Thomas discloses a reporting module (col. 2, lines 57-60; col. 4, lines 4-18; col. 16, line 40 thru col. 18, line 30 Output Reports).

Referring to claim 14:

Barney discloses a plurality of services modules interfacing with one another to provide a reference address of a potential infringer (col. 4, lines 8-15).

Referring to claim 15:

Barney discloses a method for detecting and preventing intellectual property infringement over a communication medium, said method comprising the steps of:

(a) scanning a communication medium for potentially infringing content (col. 2, lines 11-16; col. 3, line 62 thru col. 4, line 31);

(b) passing a reference address of a potential infringer to an infringement identification module (col. 4, lines 8-15);

(c) determining whether infringing content is present (col. 4, lines 19-31; Figure 2; col. 5, lines 1-56).

Barney does not disclose passing a reference address of an infringer to a cease and desist module and attempting to remove the infringing content.

However, Thomas discloses passing a reference address of an infringer to a cease and desist module and attempting to remove the infringing content (col. 11, lines 44-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property

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infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

Referring to claim 16:

Thomas discloses reporting the results of the scanning step, determining step and attempting step to an owner of intellectual property (col. 4, lines 4-16; col. 11, lines 30- 67; col. 16, line 41 thru col. 18, line 30, Figures 6-8).

Referring to claim 17:

Barney discloses passing a reference address between a plurality of scanning modules to enhance the scanning step (Figure 1; col. 3, line 62 thru col. 4, line 30).

Referring to claim 18:

Barney discloses a system for detecting and preventing intellectual property infringement over a communication medium, the system comprising:

means for scanning the communication medium for potentially infringing content (Figures 1 (100) and 2; col. 3, line 62 thru col. 4, line 31);

means for passing a reference address of a potential infringer (Figure 1 (120); col. 4, line 8-16);

means for identifying infringement comprising;

means for receiving said reference address of a potential infringer (col. 4, lines 8-16 (Figure 1 (120);

means for determining whether infringing content is present (Figure 1 (130); col. 4, lines 16-31 and col. 5, lines 1-56); and

means for passing a reference address of an actual infringer (Figure 1 (110) (130); col. 4, lines 20-31; col. 5, lines 19-34).

Barney does not disclose a means for receiving the reference address of an actual infringer and at least attempting to remove the infringing content.

However, Thomas discloses a means for receiving the reference address of an actual infringer and at least attempting to remove the infringing content (col. 11, lines 30-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cease and desist module with the intellectual property infringement detecting system of Barney so that once the offending sites are identified, cease and desist letters can be automatically be generated and sent to each offending site thus automating as much of the enforcement process as possible in order to minimize the time required by human users and maximize their effectiveness.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

Janice A. Mooneyham
SPE 3629